

PATENT

Application # 10/774,718

Attorney Docket # 2003-0029 (1014-058)

REMARKS

The Examiner is respectfully thanked for the consideration provided to this application. Reconsideration of this application is respectfully requested in light of the foregoing amendments and the following remarks.

Claim 14 has been cancelled without prejudice or disclaimer.

Each of claims 1, 19, and 20 has been amended for at least one reason unrelated to patentability, including at least one of: to explicitly present one or more elements implicit in the claim as originally written when viewed in light of the specification, thereby not narrowing the scope of the claim; to detect infringement more easily; to enlarge the scope of infringement; to cover different kinds of infringement (direct, indirect, contributory, induced, and/or importation, etc.); to expedite the issuance of a claim of particular current licensing interest; to target the claim to a party currently interested in licensing certain embodiments; to enlarge the royalty base of the claim; to cover a particular product or person in the marketplace; and/or to target the claim to a particular industry.

Claims 1-20 are now pending in this application. Each of claims 1, 19, and 20 are in independent form.

The Obviousness Rejections

Each of claims 1-20 was rejected under 35 U.S.C. 103(a) as being unpatentable over various combinations of Loomis (U.S. Patent No. 5,625,668), Bruce (U.S. Patent No. 6,765,998), Larkins (U.S. Patent No. 6,091,957), and/or Chern (U.S. Patent No. 6,456,854). These rejections are respectfully traversed.

A. *Prima Facie* Criteria

Most inventions arise from a combination of old elements and each element may often be found in the prior art. *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1457 (Fed. Cir. 1998). However, mere identification in the prior art of each element is insufficient to defeat the patentability of the combined subject matter as a whole. *Id.* at 1355, 1357. Instead, "[t]o reject

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claims in an application under section 103, an examiner must show an un rebutted *prima facie* case of obviousness." *Id.* at 1355.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure." *See* MPEP 2143.

Moreover, the "Patent Office has the initial duty of supplying the factual basis for its rejection." *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967), *cert. denied*, 389 U.S. 1057, *reh'g denied*, 390 U.S. 1000 (1968). "It may not... resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis". *Id.*

"Once the examiner... carries the burden of making out a *prima facie* case of unpatentability, the burden of coming forward with evidence or argument shifts to the applicant." *In re Alton*, 76 F.3d 1168, 37 USPQ2d 1578 (Fed. Cir. 1996) (*quoting In re Oetiker*, 977 F.2d at 1445, 24 USPQ2d at 1444).

None of the applied portions of the references relied upon in the Office Action, whether considered alone or in combination, establish a *prima facie* case of obviousness.

B. Missing Claim Limitations

Each of independent claims 1, 19, and 20 recites, *inter alia*, "receiving from a user-operated telecommunications device a user-initiated communication to a non-911 communications address" and "automatically providing a user with a spoken current location of a user-associated telecommunications device, **the user-operated telecommunications device distinct from the user-associated telecommunications device.**" The applied portions of Loomis do not expressly or inherently teach or suggest "receiving from a user-operated telecommunications device a user-initiated communication to a non-911 communications

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address” and “automatically providing a user with a spoken current location of a user-associated telecommunications device, **the user-operated telecommunications device distinct from the user-associated telecommunications device.**” Instead, Loomis allegedly recites a single “cellular telephone 12”. See col. 3, line 55 – col. 4, line 6.

The applied portions of the other applied references fail to cure at least these deficiencies of the applied portions of Loomis.

Thus, even if there were motivation or suggestion to modify or combine the applied portions of the references relied upon in the Office Action (an assumption that is respectfully traversed), and even if there were a reasonable expectation of success in combining or modifying the applied portions of the references relied upon in the Office Action (another assumption that is respectfully traversed), the applied portions of the references relied upon in the Office Action, as attempted to be modified and/or combined, still do not expressly or inherently teach or suggest every limitation of the independent claims, and consequently fail to establish a *prima facie* case of obviousness. Consequently, for at least the reasons mentioned above, reconsideration and withdrawal of these rejections is respectfully requested.

C. No Motivation or Suggestion to Combine the Applied References

“The examiner bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP 2142. The requirements for fulfilling this burden are explicit and straightforward.

“[T]he examiner **must show reasons** that the skilled artisan, **confronted with the same problems** as the inventor and with no knowledge of the claimed invention, **would select the elements** from the cited prior art references for combination **in the manner claimed.**” (emphasis added). *In re Rouffet*, 149 F.3d 1350, 1357, 47 USPQ2d 1453, 1458 (Fed. Cir. 1998). To show these reasons, “[p]articular findings must be made”. *In re Kotzab*, 217 F.3d 1365, 1371, 55 USPQ2d 1313, 1317 (Fed. Cir. 2000). Such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Moreover, a showing of combinability must be “clear and particular”. *In re Dembiczak*,

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175 F.3d 994, 999, 50 USPQ2d 1614, 161(Fed. Cir. 1999). That strong showing is needed because, “**obviousness requires proof** ‘that the skilled artisan . . . would select the elements from the cited prior art references for combination in the manner claimed’”. *In re Scott E. Johnston*, No. 05-1321, Fed. Cir.; 30 January 2006; 2006 US App. LEXIS 2282 (quotation omitted) (emphasis added).

Consequently, an Office Action must clearly and objectively prove that each applied reference is “within the field of the inventor's endeavor”, and if not, “is reasonably pertinent to the **particular problem** with which the inventor was involved”. *See In re Dillon*, 919 F.2d 688, 694 (Fed. Cir. 1990) (*en banc*) (emphasis added). Again, such factual findings must be supported by “concrete evidence in the record”. *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

In addition, “[t]he patent examination process centers on prior art and the analysis thereof. When patentability turns on the question of obviousness, the search for and analysis of the prior art includes evidence relevant to the finding of whether there is a teaching, motivation, or suggestion to select and combine the references relied on as evidence of obviousness.” *In re Sang-Su Lee*, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). Thus, the Office Action must clearly and objectively prove some “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

“select the references”;

“select the teachings of [the] separate references”; and

“combine [those teachings] in the way that would produce the claimed invention”.

In re Scott E. Johnston, No. 05-1321, Fed. Cir.; 30 January 2006; 2006 US App. LEXIS 2282) (internal citations omitted). *See also In re Dance*, 160 F.3d 1339, 1343, 48 USPQ2d 1635, 1637 (Fed. Cir. 1998) (discussing the “the test of whether it would have been obvious to select **specific** teachings and combine them as did the applicant”) (emphasis added); and *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1143, 227 USPQ 543, 551 (Fed. Cir. 1985) (“When prior art references require selective combination... to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself.”). As always, such factual findings must be supported by “concrete evidence in the

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record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Further, this obviousness standard applies regardless of whether the Office Action relies upon modifying or combining purported teachings.

Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious modification of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the **desirability** of the modification.... It is impermissible to use the claimed invention as an instruction manual or template to piece together the teachings of the prior art so that the claimed invention is rendered obvious. This court has previously stated that one cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.

In re Fritch, 972 F.2d 1260, 23 USPQ 2d 1780, 1783-1784 (Fed. Cir. 1992) (citing *In re Gorman*, 933 F.2d 982, 987, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991); *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985); and *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ 2d 1596, 1600 (Fed. Cir. 1988) (internal quotations omitted) (emphasis added)).

Therefore, the Office Action also must clearly and objectively prove that the "prior art suggested the **desirability**" of that modification or combination. *See also Akamai Techs. v. Cable & Wireless Internet Servs.*, 344 F.3d 1186, 68 USPQ 2d 1186 (Fed. Cir. 2003) ("[w]hen determining the patentability of a claimed invention which combines two known elements, the question is whether there is something in the prior art as a whole to suggest the **desirability**, and thus the obviousness, of making the combination.") (emphasis added). Once again, such factual findings must be supported by "concrete evidence in the record". *In re Zurko*, 258 F.3d 1379, 1385-86, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001).

Yet the present Office Action fails to prove a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";

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2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

1. Claim 12

Claim 12 recites, *inter alia*, "via wireless packet data, providing to the user-operated telecommunications device information indicative of the current location of the user-associated telecommunications device." The relied upon portions of Loomis do not teach or suggest, expressly or inherently, "via wireless packet data, providing to the user-operated telecommunications device information indicative of the current location of the user-associated telecommunications device."

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Larkins. Regarding the combination of Larkins, the present Office Action asserts at page 4 that:

Larkins teaches the well known use of Cellular Digital Packet Data (CDPD) protocols in a location determining system (col. 2, line 42) such that it would have been obvious to an artisan of ordinary skill to incorporate such use of wireless packet data protocol, as taught by Larkin [sic], within the combination of Loomis and Bruce.

Yet this assertion fails to present any evidence whatsoever regarding a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Accordingly, a withdrawal of the rejection of claim 12 is respectfully requested.

2. Claim 18

Claim 18 recites, *inter alia*, "wherein the user-associated telecommunications device is a wireline user-operated telecommunications device." The relied upon portions of Loomis do not

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teach or suggest, expressly or inherently, "wherein the user-associated telecommunications device is a wireline user-operated telecommunications device."

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Larkins. Yet the present Office Action fails to provide any evidence whatsoever regarding a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Accordingly, a withdrawal of the rejection of claim 18 is respectfully requested.

3. Claim 2

Claim 2 recites, *inter alia*, "receiving a communications address of the user-associated telecommunications device." The relied upon portions of Loomis do not teach or suggest, expressly or inherently, "receiving a communications address of the user-associated telecommunications device."

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Chern. Regarding the combination of Chern, the present Office Action asserts at pages 4-5 that "[i]t would have been obvious to an artisan of ordinary skill to incorporate such location tracking over the Internet, as taught by Chern, within the method of Loomis and Bruce as additional use of a mobile telephone's current location."

Yet this assertion fails to present any evidence whatsoever regarding a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Accordingly, a withdrawal of the rejection of claim 2 is respectfully requested.

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Claim 3 recites, *inter alia*, "receiving a communications address of the user-associated telecommunications device from the user." The relied upon portions of Loomis do not teach or suggest, expressly or inherently, "receiving a communications address of the user-associated telecommunications device from the user."

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Chern. Regarding the combination of Chern, the present Office Action asserts at pages 4-5 that "[i]t would have been obvious to an artisan of ordinary skill to incorporate such location tracking over the Internet, as taught by Chern, within the method of Loomis and Bruce as additional use of a mobile telephone's current location."

Yet this assertion fails to present any evidence whatsoever regarding a "suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to":

1. "select the references";
2. "select the teachings of [the] separate references"; or
3. "combine [those teachings] in the way that would produce the claimed invention".

Accordingly, a withdrawal of the rejection of claim 3 is respectfully requested.

5. Claim 4

Claim 4 recites, *inter alia*, "receiving at an Internet site a communications address of the user-associated telecommunications device." The relied upon portions of Loomis do not teach or suggest, expressly or inherently, "receiving at an Internet site a communications address of the user-associated telecommunications device."

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Chern. Regarding the combination of Chern, the present Office Action asserts at pages 4-5 that "[i]t would have been obvious to an artisan of ordinary skill to incorporate such location tracking over the Internet, as taught by Chern, within the method of Loomis and Bruce as additional use of a mobile telephone's current location."

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Yet this assertion fails to present any evidence whatsoever regarding a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed invention”.

Accordingly, a withdrawal of the rejection of claim 4 is respectfully requested.

6. Claim 5

Claim 5 recites, *inter alia*, “recording a communications address of the user-associated telecommunications device.” The relied upon portions of Loomis do not teach or suggest, expressly or inherently, “recording a communications address of the user-associated telecommunications device.”

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Chern. Regarding the combination of Chern, the present Office Action asserts at pages 4-5 that “[i]t would have been obvious to an artisan of ordinary skill to incorporate such location tracking over the Internet, as taught by Chern, within the method of Loomis and Bruce as additional use of a mobile telephone’s current location.”

Yet this assertion fails to present any evidence whatsoever regarding a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed invention”.

Accordingly, a withdrawal of the rejection of claim 5 is respectfully requested.

7. Claim 13

Claim 13 recites, *inter alia*, “providing the user with a communications address to contact to modify information indicative of the current location of the user-associated

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telecommunications device.” The relied upon portions of Loomis do not teach or suggest, expressly or inherently, “providing the user with a communications address to contact to modify information indicative of the current location of the user-associated telecommunications device.”

In an attempt to overcome the deficiencies of Loomis, the present Office Action attempts to combine Loomis with Bruce and Chern. Regarding the combination of Chern, the present Office Action asserts at page 5 that:

Chern teaches the user manually sending current location information to the Web server (col. 6, lines 11-34) such that it would have been obvious to an artisan of ordinary skill to have the user send current location data to a provided communications address (Web server address), as taught by Chern, within the method of Loomis and Bruce in order to provide the most current location data.

Yet this assertion fails to present any evidence whatsoever regarding a “suggestion, motivation, or teaching in the prior art that would have led a person of ordinary skill in the art to”:

1. “select the references”;
2. “select the teachings of [the] separate references”; or
3. “combine [those teachings] in the way that would produce the claimed invention”.

Accordingly, a withdrawal of the rejection of claim 13 is respectfully requested.

D. Obviousness Summary

Thus, there is no motivation or suggestion to combine the applied portions of Loomis with the applied portions of Bruce, Larkins, and/or Chern to arrive at the claimed subject matter. Because no *prima facie* rejection of any independent claim has been presented, no *prima facie* rejection of any dependent claim can be properly asserted. Consequently, reconsideration and withdrawal of these rejections is respectfully requested.

It is respectfully noted that because the Office Action fails to set forth sufficient facts to provide a *prima facie* basis for all of the rejections, any future rejection based on the applied references will necessarily be factually based on an entirely different portion of that reference, and thus will be legally defined as a “new grounds of rejection.” Consequently, any Office

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Action containing such rejection can not properly be made final. *See In re Wiechert*, 152 USPQ 247, 251-52 (CCPA 1967) (defining “new ground of rejection” and requiring that “when a rejection is factually based on an entirely different portion of an existing reference the appellant should be afforded an opportunity to make a showing of unobviousness vis-a-vis such portion of the reference”), and *In re Warner*, 379 F.2d 1011, 154 USPQ 173, 178 (CCPA 1967) (the USPTO “has the initial duty of supplying the factual basis for its rejection”).

Allowable Subject Matter

A potential statement of reasons for the indication of allowable subject matter is:
“none of the reference of record, alone or in combination, teach or suggest the combination of limitations found in the independent claims. Namely, claims 1-20 are allowable because none of the references of record, alone or in combination, teach or suggest ‘receiving from a user-operated telecommunications device a user-initiated communication to a non-911 communications address’ and ‘automatically providing a user with a spoken current location of a user-associated telecommunications device, the user-operated telecommunications device distinct from the user-associated telecommunications device.’”

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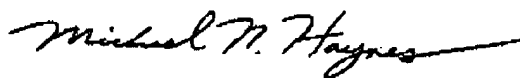
CONCLUSION

It is respectfully submitted that, in view of the foregoing amendments and remarks, the application as amended is in clear condition for allowance. Reconsideration, withdrawal of all grounds of rejection, and issuance of a Notice of Allowance are earnestly solicited.

The Office is hereby authorized to charge any additional fees or credit any overpayments under 37 C.F.R. 1.16 or 1.17 to Deposit Account No. 50-2504. The Examiner is invited to contact the undersigned at 434-972-9988 to discuss any matter regarding this application.

Respectfully submitted,

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